

REMARKS

Claims 1 and 100-116 are pending in the above-identified patent application. No claims are allowed.

Claim 117 has been added.

The First 35 U.S.C. § 103(a) Rejection

Independent claims 1 and 100 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Irribarren¹ in view of Picard et al.^{2 3}. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.⁴

Specifically, the Examiner contends that the elements of the presently claimed invention are disclosed in Irribarren, except that Irribarren teaches neither a connection notification means nor a message notification means.⁵ The Examiner further contends that Picard et al. taught a

¹ USP 5,737,395.

² USP 6,233,318.

³ Office Action dated June 5, 2002, ¶ 4.

⁴ M.P.E.P § 2143.

⁵ Office Action ¶ 5.

multimedia message communication having connection notification means and a message notification means and that it would have been obvious to one of ordinary skill in the networking art at the time of the invention to have incorporated Picard et al.'s teachings of unifying message storage allowing different types of messages or electronic communications such as voicemail, facsimile, e-mail and video mail to be stored on a single system in a single unified multimedia mailbox, and accessed via different pathways, such as via a telephone network or Internet/Intranet with the teachings of Irribarren for the purpose of integrating the message system through the personal computer or Internet Communication Device either locally or remotely.⁶ The Applicants respectfully disagree for the reasons set forth below.

Irribarren and Picard et al. Do Not Teach or Suggest All Claim Limitations

When evaluating a claim for determining obvious, all limitations of the claim must be evaluated. 35 USC § 103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains...⁷ (Emphasis supplied)

Claim 1

Claim 1 recites in part:

An apparatus for storing and forwarding messages, the apparatus comprising:
 a first network interface for interfacing with a network;
 a second network interface for interfacing with an Internet network;
 means for receiving an incoming message and delivery information from said first network interface, said incoming message having a message content format of a first type;

⁶ Office Action ¶ 5.

⁷ USC § 103.

a converter for converting said incoming message having a message content format of a first type to a message having a message content format of a second type in response to said incoming message and said delivery information, said converter using said delivery information for selecting said message content format of a second type for said message;

means for presenting said message having said message content format of a second type to at least one recipient specified in said delivery information, said message content format of a second type including a format where said message is stored in a location in memory, said location in memory pointed to by location information, said means for presenting having a means for creating a web page for presenting said incoming message;

Claim 1 also recites in part:

connection notification means for providing a recipient connection signal to the apparatus when a browser connects to said Internet network, said browser associated with a recipient of said incoming message;

The Examiner states:

Picard teaches the IMS HTTP server 146 sends the home page in the response to the GET, and the PC's browser 144 displays it. The home page has welcome text and/or graphics and/or voice announcement. The calling line identifier (CLI) can be used to verified that the calling number matches the subscriber name, or using the authentication capabilities of HTTP, col. 10, lines 29-59).⁸

The Examiner cites the following in support of the contention:

b. The PC 142 sends an HTTP GET method for the home page URI.

c. The IMS HTTP server 146 sends the home page *in the response to the GET*, and the PC's browser 144 displays it. The home page has welcome text and/or graphics and/or voice announcement, including a password entry field. For users wishing to leave a message for the subscriber instead of logging in, there is preferably a "button" on the subscriber's home page to "leave a message". The calling line identifier (CLI) can be used to verify that the calling number matches the subscriber name, or for using the authentication capabilities of HTTP. A secure socket layer (SSL) is used to provide an initial secure connection for authentication. A menu of additional services besides integrated messaging can also be provided.

d. Using browser 144, the subscriber enters the password in the login information form, the browser 144 sends it to the HTTP server 146. The server 146 validates the password and synthesizes the subscriber's main messaging page ("http://www.mail.somerboc.com/JoeQuser/inbox) from the contents of the subscriber's message store, and returns the page to the browser 144. The subscriber's messaging page

⁸ Office Action ¶ 25(C).

contains links to each of his stored messages (“http://www.mail.somerboc.com/awscripts/btv.dll?REFRESH”) and whatever inventory information (“http://www.mail.somerboc.com/awscripts/btv.dll?DRTR&Unique MsgId”) is desired for display, plus buttons for sending, deleting, forwarding or other message actions.⁹

The Picard et al. reference further discloses:

During a typical session a user will access the platform 132 over the Internet 136 using a standard web browser to obtain a service provider home page where the user will log into the Internet service provided by the platform.¹⁰

The Picard et al. reference further discloses:

During this process the user is required to enter a mailbox identifier and a pass code which are checked to ensure that the user is authorized. Once authorization is confirmed a service session is initiated and the user is presented a page that includes a menu of service options such as viewing a message list, administering mail box options, other network service features, etc.¹¹

Contrary to the Examiner’s statement, Picard et al. does not teach “connection notification means for providing a recipient connection signal to the apparatus when a browser *connects* to said Internet network, said browser associated with a recipient of said incoming message”. Instead, Picard et al. discloses displaying a message list after a browser that *already has access to the Internet* is used to obtain a service provider home page, and *after the user logs in to the Internet service* provided by the platform. For this reason, the Examiner has failed to make a *prima facie* case of obviousness so the 35 U.S.C. § 103 rejection should be withdrawn.

Claim 1 also recites in part:

message notification means for sending message waiting notification to said recipient via said browser if said recipient connection signal is received from said connection notification means and if at least one message has been received for delivery to said recipient.

⁹ Picard et al. at col. 10, lines 29-59 (emphasis added).

¹⁰ Picard et al. at col. 15 lines 61-65.

¹¹ Picard et al. at col. 15 lines 65-67, col. 16 lines 1-4.

According to the Examiner, Picard et al. discloses:

message notification means (refresh button) (Picard, col. 16, line 54-55) for sending message waiting (new message) notification.¹²

Contrary to the Examiner's statement, Picard et al. does not teach a message notification means for sending message waiting notification to said recipient via said browser if said recipient connection signal is received from said connection notification means and if at least one message has been received for delivery to said recipient. The refresh button disclosed in Picard et al. requires user interaction with a browser to initiate the refresh operation¹³. Furthermore, as mentioned above, the connection notification means disclosed in Picard et al. differs from the connection notification means as disclosed and claimed in claim 1. The Examiner is reminded that the mere absence from a reference of an explicit requirement of a claim cannot be reasonably construed as an affirmative statement that the requirement is in the reference.¹⁴ For this additional reason, the Examiner has failed to make a *prima facie* case of obviousness so the 35 U.S.C. § 103 rejection should be withdrawn.

Claim 100

Claim 100 recites:

A communication system having a virtual mailbox feature, comprising:
 a first messaging apparatus having a first network interface coupled to and for transceiving messages through an Internet network, a second network interface coupled to and for transceiving messages through a first telephone network, a universal mailbox associated with a first subscriber; and
 a second messaging apparatus having a third network interface coupled to an for transceiving messages through said Internet network, a fourth network interface coupled to and for transceiving messages through a second telephone network, a virtual mailbox associated with said first subscriber and for storing a message addressed to said first

¹² Office Action ¶ 5.

¹³ Picard et al. at col. 16 lines 45-46.

¹⁴ *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

subscriber and received through said second telephone network, and a forwarding program for transmitting said message to said first messaging apparatus via said Internet network.

The Examiner states:

Irribarren-Picard teaches:

a communication system having virtual mailbox feature (Picard, Figs. 7, 8, 9, 10; col. 1, lines 55-67; col. 2, lines 34-40), comprising:

a first message apparatus having a first network interface coupled to and for transceiving messages through the internet network,

a second network interface coupled to and for transceiving messages through a first telephone network (Picard, for PC access, two physical interface types are provided: dial-up to IMS telephone ports, and via the Internet (or another TCP/IP network), col. 9, lines 28-39),

a universal mailbox associated with a first subscriber (single integrated mailbox for an user to access from external systems, Picard, col. 4, lines 15-24); and

a second messaging apparatus having a third network interface coupled to and for transceiving messages through said Internet network,

a fourth network interface coupled to and for transceiving messages through a second telephone network (Picard, for PC access, two physical interface types are provided: dialup to IMS telephone ports, and via the Internet (or another TCP/IP network), col. 9, lines 28-39),

a virtual mailbox associated with said first subscriber and received through said second telephone network (Picard, virtual integrated mailbox provides the same subscriber-visible functionality, and appear the same to the subscriber as a real integrated mailbox. However, in the virtual integrated mailbox, the subscriber's messages are stored in at least two different messaging systems (MSs) whose configuration can be (but need not be) performed separately, col. 4, lines 34-52), and a forwarding program for transmitting said message to said first messaging apparatus via said Internet network (col. 8, lines 59-67; col. 9, lines 1-10; col. 10, lines 46-67; col. 11, lines 1-16).¹⁵

Picard teaches a communication having a virtual mailbox feature (see rejection of claim 100 above).¹⁶

According to the Examiner, Irribarren in combination with Picard et al. discloses a communication system having a virtual mailbox feature.¹⁷ The text cited by the Examiner speaks generally about the need for a system that allows subscriber access to stored messages that are stored in a unified multimedia mailbox through a public switched telephone network and

¹⁵ Office Action ¶ 6.

¹⁶ Office Action ¶ 25(D).

over a data network such as the Internet.¹⁸ The Examiner also makes reference to FIGS. 7-10 in Picard et al.¹⁹ Figure 7 illustrates the flow of control during a refresh operation. Figures 8 and 9 depict message list and group list templates, respectively, and Figure 10 illustrates the flow of control in a retrieval operation. It is unclear how the cited references disclose a communication system having a virtual mailbox feature as disclosed and claimed in claim 100. The Applicants submit that the Examiner has failed to present a convincing line of reasoning supporting the rejection.²⁰ For this reason, the Examiner has failed to make a *prima facie* case of obviousness so the 35 U.S.C. § 103 rejection should be withdrawn.

Furthermore, the Examiner cites the following in support of the contention that Picard et al. discloses both a second network interface coupled to and for transceiving messages through a first telephone network, and a fourth network interface coupled to and for transceiving messages through a second telephone network:

For PC access, two physical interface types are provided: dialup to the IMS telephone ports, and via the Internet (or another TCP/IP network). In addition, several ways to handle voice messages are provided: purely digital, where the voice data is simply transferred like any other type of data (such as by using a browser as previously discussed), and the PC turns it into audio; the use of a voice/data line-sharing scheme, such as provided with the VoiceView system available from Radish (the latter would only be available through the IMS dial-up ports) and transfer of the voice data via an e-mail attachment with the conversion to audio occurring in the PC.²¹

Nowhere does Picard et al. disclose both a second network interface coupled to and for transceiving messages through a *first telephone network*, and a fourth network interface coupled to and for transceiving messages through a *second telephone network*. For this additional reason,

¹⁷ Office Action ¶ 5.

¹⁸ Picard et al. at col. 1 lines 55-67, col. 2 lines 34-40.

¹⁹ Office Action ¶ 5.

²⁰ See *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

the Examiner has failed to make a *prima facie* case of obviousness so the 35 U.S.C. § 103 rejection should be withdrawn.

The Second 35 U.S.C. § 103(a) Rejection

Claims 101-114 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Irribarren in view of Picard et al. and further in view of Chau et al.²², among which claims 103, 105, 111 and 113-114 are independent claims.²³ This rejection is respectfully traversed.

Specifically, the Examiner states that Irribarren and Picard et al. disclose most of the claimed elements and Chau et al. discloses the rest of the claimed elements.²⁴ The Applicants respectfully disagree for the reasons set forth below.

Irribarren, Picard et al. and Chau et al. Do Not Teach or Suggest All Claim Limitations

Dependent Claims 101 and 102

Claims 101 and 102 depend from claim 100. As noted above, Irribarren and Picard et al. do not make claim 100 obvious. For the same reasons, Irribarren, Picard et al. and Chau et al. cannot be said to make claims 101 and 102 obvious.

Claim 103

Claim 103 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 103. Therefore, the

²¹ Picard et al. at col. 9 lines 28-39.

²² USP 5,751,792.

²³ Office Action ¶ 7.

²⁴ Office Action ¶ 8.

Applicants respectfully submit that claim 103 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Claim 104

Claim 104 depends from claim 103. The argument set forth above with respect to claim 103 is equally applicable here. The base claim being allowable, the dependent claim must also be allowable.

Claim 105

Claim 105 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 105. Therefore, the Applicants respectfully submit that claim 105 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Claim 105 recites:

A communication system having a roaming mailbox feature, comprising:
a first messaging apparatus having a first network interface coupled to and for transceiving messages through an Internet network, a second network interface coupled to and for transceiving messages through a first telephone network, said first telephone network serving a first geographical area, a universal mailbox associated with a first subscriber and for storing a message addressed to said subscriber, and a forwarding program for transmitting said message addressed to said subscriber to a second messaging apparatus via said Internet network;
wherein said second messaging apparatus includes a third network interface coupled to and for transceiving messages through said Internet network, a fourth network interface coupled to and for transceiving messages through a second telephone network, a roaming mailbox associated with said first subscriber and for storing said message addressed to said subscriber and received through said Internet network from said first messaging apparatus; and
wherein said roaming mailbox is accessible by said subscriber via said second telephone network, said second telephone network serving a second geographical area.

The Examiner states:

Iribarren-Picard-Chau discloses a communication system having a roaming mailbox feature, comprising:

- a. a first messaging apparatus (Chau, Fig. 1, node A) having a first network interface (Chau, Fig. 1, arrow 118) coupled to and for transceiving messages through an Internet network (Chau, Fig. 1, item 116);
 - a second network interface (Chau, Fig. 2, dash lines 210, 220) coupled to and for transceiving message through a first telephone network (Chau, Fig. 2, box 200), said first telephone network serving a first geographical area,
 - an universal mailbox (home mailbox) associated with a first subscriber and for storing a message addressed to said subscriber (Chau, Fig. 2, boxes 204, 206; col. 2, lines 46-67; col. 3, lines 1-21), and
 - a forwarding program for transmitting said message addressed to said subscriber to second messaging apparatus via said Internet network (Picard, Fig. 6, boxes 142, 144);
 - wherein said second interface messaging apparatus includes a third network interface (Chau, Fig. 1, arrow 118) coupled to and for transceiving messages through said Internet network,
 - a fourth network interface coupled to and for transceiving messages through a second telephone network (Chau, Fig. 2, box 200 at roaming nodes B, C),
 - a roaming mailbox associated with said first subscriber and for storing said message addressed to said subscriber and received through said Internet network from said first message apparatus; and
 - wherein said roaming mailbox is accessible by said subscriber via said second telephone network, said second telephone network serving a second geographical area (Chau, Abstract; Fig. 1, col. 1, lines 35-40; col. 4, lines 9-31).²⁵

In support of the contention that Picard et al. discloses a forwarding program for transmitting said message addressed to said subscriber to a second messaging apparatus via said Internet network, the Examiner refers to Picard et al., FIG. 6, boxes 142 and 144. Box 142 refers to a personal computer and box 144 refers to a browser. As mentioned previously, the browser in Picard et al. allows a user to connect with an Internet service provider and send or receive messages. Picard et al. does not disclose or suggest using the browser as a forwarding program for transmitting said message addressed to said subscriber to a second messaging apparatus via said Internet network. Thus, the Examiner has failed to make a *prima facie* case of obviousness so the 35 U.S.C. § 103 rejection should be withdrawn.

Claims 106-110

Claims 106-110 depend from claim 105. The argument set forth above with respect to claim 105 is equally applicable here. The base claim being allowable, the dependent claims must also be allowable.

Claim 111

Claim 111 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 111. Therefore, the Applicants respectfully submit that claim 111 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Claim 112

Claim 112 depends from claim 111. The argument set forth above with respect to claim 111 is equally applicable here. The base claim being allowable, the dependent claim must also be allowable.

Claim 113

Claim 113 recites:

A method of delivering a message to a recipient serviced by a messaging apparatus defined within a multimedia messaging communications system, comprising:
receiving a destination telephone number from a subscriber of the communications system;
receiving a message intended for delivery to said destination telephone number;
routing said message to a local telephone network if said destination telephone number includes a telephone prefix code which corresponds to said local telephone network;
routing said message to a remote messaging apparatus which is coupled to a remote telephone network, if said destination telephone number includes a prefix code which corresponds to said remote telephone network; and

²⁵ Office Action ¶ 12.

delivering said message by using said remote messaging apparatus to establish a local call to a telephone interface which is defined within said remote telephone network.

The Examiner states:

Irribarren-Picard-Chau discloses, a method of delivering a message to a recipient serviced by a messaging apparatus defined within a multimedia messaging communication system (Picard, Figs. 4, 6; Chau, Figs. 1, 2, col. 2, lines 8-11) comprising:

- a. receiving a destination telephone number from a subscriber of communication system (Picard teaches the IMS 106 provides an HTTP server (IPU 146) to handle the requests from the browser, and provides an organization of the information in the IMS 106 into a logical structure, (col. 10, lines 7-22); Chau, teaches that the subscriber can be associated with any station (S1, S2, S3, S4) at any node (A, B, or C) in the system and accesses the system at any of them to obtain his/her messages, col. 4, lines 10-15);
- b. receiving said message intended for delivery to said destination telephone number (Picard teaches the IMS 106 is able to present a single list or inventory, containing all messages of all types (sorted into types), to the subscriber when he logs into his mailbox, and provide the ability to select messages for retrieval, col. 6, lines 29--67; Picard also teaches for users wishing to leave a message for the subscriber instead of logging in, there is preferably a "button" on the subscriber's home page to "leave a message", col. 10, lines 33-45; Chau, teaches that the subscriber can receive his/her messages from any node (A,B,C), col. 4, lines 26-27);
- c. routing said message to a local telephone network if said destination telephone number includes a telephone prefix code which corresponds to said local telephone network; routing said message to a remote messaging apparatus which is coupled to a remote telephone network, if said destination telephone number includes a prefix code which corresponds to said remote telephone network; and delivering said message by using said remote messaging apparatus to establish a local to telephone interface which is defined within said remote telephone network (Chau, teaches PBX 200 besides providing network access to node 108, functions to transfer calls between the network and the messaging equipment. It also provides remote access to mailboxes, i.e., memory locations for storing messages through a WAN or a software defined network (SIDN). PBX routes calls to customer support centers and provides basic outbound calls for messaging delivery. PBX is used as programmable switch fabric which is controlled by host 202 (col. 2, lines 54-62); and Chau also teaches that in Fig.1, station sets S1, S2, S3, S4 are connected to Central Offices (COs) 102, 104, 106, respectively, maintained by a local exchange carrier (LEC) or a postal, telephone and telegraph company (PTT). The operation of a CO is well known, col. 2, lines 1-43).²⁶

Claim 113 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 113. Therefore, the

²⁶ Office Action ¶ 19.

Applicants respectfully submit that claim 113 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

Additionally, according to the Examiner, Chau et al. discloses receiving said message intended for delivery to said destination telephone number²⁷. The Examiner cites the following in support of this contention:

A subscriber can then obtain his/her messages from roaming node C.²⁸

Thus, the cited reference discloses receiving a *delivered* message, not receiving a message *intended for delivery* to a destination telephone number. For this additional reason, it cannot be said that Irribarren in combination with Picard et al. and Chau et al. make the presently claimed invention obvious.

Claim 114

Claim 114 includes limitations similar to those of claims 1 and 100. Accordingly, the previous remarks regarding claims 1 and 100 are equally applicable to claim 114. Therefore, the Applicants respectfully submit that claim 114 is similarly not rendered obvious under § 103 by Chau et al., either alone or in combination with Irribarren and Picard et al.

In view of the foregoing, it is respectfully requested that the rejection of claims 101-114 be withdrawn.

²⁷ Office Action ¶ 6, p. 9.

²⁸ Chau et al. at col. 4 lines 26-27.

The Third 35 U.S.C. § 103(a) Rejection

Independent claim 115 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Irribarren in view of Picard et al. and further in view of Chau et al. and further in view of the “well-known feature of using program instructions stored on computer readable medium to perform the method of operations.”²⁹

Claim 115 includes limitations similar to claim 113. As noted above, Irribarren, Picard et al. and Chau et al. do not make claim 113 obvious. For the same reasons, Irribarren, Picard et al. Chau et al. and the “well-known feature of using program instructions stored on computer readable medium to perform the method of operations” cannot be said to make claim 115 obvious.

Claim 116

Claim 116 includes limitations similar to claim 113. As noted above, Irribarren, Picard et al. and Chau et al. do not make claim 113 obvious. For the same reasons, Irribarren and Picard et al. Chau et al. cannot be said to make claim 116 obvious.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned “Version with markings to show changes made.”

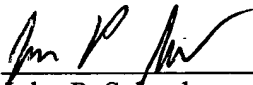
Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1698.

Respectfully submitted,
Thelen Reid and Priest LLP

Dated: October 7, 2002



John P. Schaub
Reg. No. 42,125

Thelen Reid and Priest
P.O. Box 640640
San Jose, CA 95164-0640
(408) 282-1858

²⁹ Office Action ¶ 21.

VERSION WITH MARKINGS TO SHOW CHANGES MADE**In the Claims**

Please add claim 117 as follows:

117. (NEW) A method of delivering a message to a recipient serviced by a messaging apparatus defined within a multimedia messaging communications system, comprising:
- step for receiving a destination telephone number from a subscriber of the communications system;
 - step for receiving a message intended for delivery to said destination telephone number;
 - step for routing said message to a local telephone network if said destination telephone number includes a telephone prefix code which corresponds to said local telephone network;
 - step for routing said message to a remote messaging apparatus which is coupled to a remote telephone network, if said destination telephone number includes a prefix code which corresponds to said remote telephone network; and
 - step for delivering said message by using said remote messaging apparatus to establish a local call to a telephone interface which is defined within said remote telephone network.